

Applicant's Docket No. 10016958-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor Application of:

Sesek, et al.

Serial No.: 10/052,735

Filed: January 18, 2002

For: System and Method for Sending Documents

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Group Art Unit: To be assigned

Examiner: To be assigned

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JUL 21 2003

Technology Center 2100

**ATTENTION: Director of Office of Initial Patent Examination (M.P.E.P. §1002.02(q))**

**PETITION FOR CORRECTION OF INVENTORSHIP OF PATENT APPLICATION  
(37 C.F.R. § 1.48(d) and (e))**

*NOTE: See § 201.03 of the M.P.E.P. (6<sup>th</sup> ed., rv. 3)*

1. This is a petition for correction of error in a

*(check the appropriate item below)*

- ☐ misjoinder  
☒ nonjoinder


of inventor(s) in the above issued patent. It is respectfully requested that the PTO correct the error in inventorship.

2. Enclosed herewith is (37 C.F.R. §1.48(d)(1) and 1.48 (e)(1),(2)):

- ☒ a statement from a registered attorney of record to correct the inventorship and that identifies the inventor being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor; and  
☒ a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive invention on his or her part.

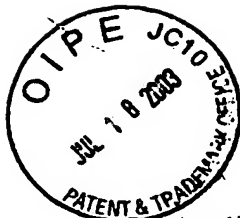
4. The fee required (37 C.F.R. §1.17(i)) is paid as follows:

- ☐ Enclosed is a check for \$130.00  
☒ Charge Deposit Account 08-2025 \$130.00.

  
\_\_\_\_\_  
SIGNATURE OF PRACTITIONER

David R. Risley; Reg. No. 39,345  
SIGNATURE OF PRACTITIONER

*(type or print name of practitioner)*



2172  
#6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Sesek, et al.

Serial No.: 10/052,735

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REQUEST FOR CORRECTION OF INVENTORSHIP

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Technology Center 2100

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

In regard to the above-noted application, applicant submits the following Request for Correction of Inventorship.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 08-2025.

CERTIFIED MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as "First Class Mail," in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Alexandria, Virginia 22313-1450 on

July 15, 2003

Signature: \_\_\_\_\_

Mary Megan

## **I. Statement of Request**

Pursuant to 37 C.F.R. § 1.48(a), applicant hereby requests correction of the inventorship of the above-noted patent application (Serial No. 10/052,735). At present, the application names Robert Seseek, Chris Struble, and Chad Stevens as joint inventors of the claimed subject matter. In that Travis J. Parry (hereinafter "Mr. Parry") also contributed to the conception of the claimed subject matter, this Motion seeks to add Mr. Parry as named inventor in the application.

As is discussed below, the original inventorship error occurred without deceptive intention. Included with this Request is an affidavit from the unintentionally excluded inventor, a newly executed Declaration for Patent Application, the fee required by 37 C.F.R. § 1.17(i), and the written consent of the assignee.

## **II. Statement of Facts**

1. The patent application presently names three inventors, Robert Seseek, Chris Struble, and Chad Stevens.

2. Despite not being identified as named inventors upon the filing of the patent application, Mr. Parry contributed to the conception of the subject matter of the patent application.

3. Mr. Parry does not know why he was excluded from the application, however, he avers that the error occurred without any deceptive intention on his part.

### **III. Statement of the Reasons Why Relief Should Be Granted**

The correction of inventorship for U.S. Patent Applications is governed by 37 C.F.R. § 1.48. Under § 1.48, correction of inventorship is permissible if the present designation of inventorship is incorrect due to an error that arose without any deceptive intention on the part of the inventor or inventors that, through error, were not named as inventors. 37 C.F.R. § 1.48(a). Each of these requirements is satisfied in the instant case, as discussed below.

#### **A. The Original Designation of Inventorship is Incorrect**

As stated above, the first element to establish before inventorship may be amended is that the original designation of inventorship is incorrect. The case law makes clear that conception is the key to determining inventorship. See Sewall v. Walters, 21 F.3d 411, 415, 30 U.S.P.Q.2d 1356, 1358 (Fed. Cir. 1994) (“Determining ‘inventorship’ is nothing more than determining who conceived the subject matter at issue”); Fina Oil & Chem. Co. v. Ewen, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997) (“Conception is the touchstone to determining inventorship”). As expressed by the Court of Appeals for the Federal Circuit, although there is no explicit lower limit on the quantum or quality of the inventive contribution for qualification as a joint inventor, a joint inventor “must contribute in some significant manner to the conception of the invention.” Fina Oil, at 1473, 1941 (citations omitted). Furthermore, a person is not a co-inventor if his or her contribution merely equates to an explanation to the actual inventor concepts that are well known in the art. Id.

In the instant case, Mr. Parry clearly contributed to the conception of the claimed invention as evidenced by his declaration.

**B. The Original Designation of Inventorship Was Made Without Deceptive Intention**

Under Rule 48, the original incorrect designation of inventorship must have occurred due to “error” that arose without “deceptive intention” on the part of the omitted inventor(s). 37 C.F.R. § 1.48(a). It has been long established that the meaning of the term “error” includes not only errors in recordation and transcription, but also errors of judgment, *i.e.*, mistakes. In re Schmidt, 293 F.2d 274, 278, 130 USPQ 404, 408 (C.C.P.A. 1961)(35 U.S.C. § 116 permits correction for bona fide mistakes in joining a person as an inventor). Indeed, with the liberalization of the requirements pertaining to correction of inventorship that has taken place over the latter half of this century, “error” has been construed to include even “gross” misunderstandings of patent law on the part of the inventor's patent attorneys, as long as each misunderstanding was innocent. See Azoplate Corp. v. Silverlith, Inc., 367 F. Supp. 711, 729, 180 U.S.P.Q. 616, 629 (D.C. Del. 1973)(innocent mistakes as to the law made by the inventor's patent attorney qualify as errors under 35 U.S.C. § 116).

Although it is unclear why Mr. Parry was not included as named inventors on this application. In any case, Mr. Parry has averred that this omission occurred without deceptive intention.

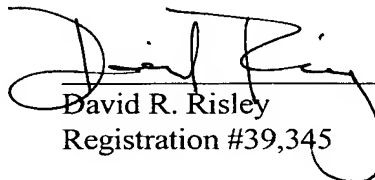
**C. The Procedural Formalities of Rule 48 Have Been Satisfied**

Included with the present Request is a statement from each person being added as an inventor that the error occurred without deceptive intention on his or her part, a newly executed declaration, the processing fee set forth in 37 C.F.R. § 1.17(i), and the written consent of the assignee. Accordingly, each of the requirements of 37 C.F.R. § 1.48(a) has been met.

IV. Conclusion

The instant Request for Correction of Inventorship, and its accompanying exhibits, satisfy the requirements of 37 C.F.R. § 1.48(a). Thus, applicant respectfully requests that Mr. Parry be added as inventor to the instant application.

Respectfully submitted,

  
David R. Risley  
Registration #39,345

Date: 7/15/03

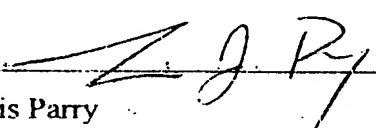
**AFFIDAVIT OF TRAVIS PARRY**

The undersigned, Travis Parry, declares and states as follows:

1. I am not currently a named inventor of United States Patent Application No. 10/052,735 ("the '735 application"), filed January 18, 2002.
2. Despite not being named as an inventor in the '735 application, I contributed to the conception of the invention claimed in the '735 application.
3. My omission from the inventorship identified in the '735 application was, to my knowledge, a clerical error.
4. In addition, this omission occurred without any deceptive intention on my part.



I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

  
\_\_\_\_\_  
Travis Parry  
J. R.

03/04/2003  
\_\_\_\_\_  
Date

DECLARATION AND POWER OF ATTORNEY  
FOR PATENT APPLICATION

KEY DOCKET NO. 10016958.1

As a below named inventor, I hereby declare that:  
 My residence/post office address and citizenship are stated below next to my name;  
 I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**Systems and Methods for Sending Documents**

the specification of which is attached hereto unless the following box is checked:

(X) was filed on 1/18/02 as US Application No. or PCT International Application  
 Number 10/052,735 and was amended on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.

**Foreign Application(s) and/or Claim of Foreign Priority**

I hereby claim foreign priority benefits under Title 35, United States Code Section 119 of any foreign application(s) for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate having a filing date before that of the application on which priority is claimed:

COUNTRY	APPLICATION NUMBER	DATE FILED	PRIORITY CLAIMED UNDER 35 U.S.C. 119
			YES: _____ NO: _____
			YES: _____ NO: _____

**Provisional Application**

I hereby claim the benefit under Title 35, United States Code Section 119(e) of any United States provisional application(s) listed below:

APPLICATION NUMBER	FILING DATE

**U. S. Priority Claim**

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

APPLICATION NUMBER	FILING DATE	STATUS (patented/pending/abandoned)

**POWER OF ATTORNEY:**

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Customer Number 022879Place Customer  
Number Bar Code  
Label here**RECEIVED**

Send Correspondence to:  
 HEWLETT-PACKARD DEVELOPMENT COMPANY  
 Intellectual Property Administration  
 P.O. Box 272400  
 Fort Collins, Colorado 80527-2400

Direct Telephone Calls To:

JUL 21 2003

Anthony J. Baca  
 (208) 376-3597

**Technology Center 2100**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Inventor: Robert SeseCitizenship: USResidence: 3277 East Redstone Drive, Boise, ID 83712-8581Post Office Address: same as above2285 NORTH HICKORY WAY, MERIDIAN ID 83642

Inventor's Signature

Date

11-MAR-2003

DECLARATION AND POWER OF ATTORNEY  
FOR PATENT APPLICATION (continued)

ATTORNEY DOCKET NO. 10016958-1

Full Name of # 2 joint inventor: Chris Struble

Citizenship: US

Residence: 7280 Hidden Valley Drive, Boise, ID 83709 CLS

Post Office Address: Same as above

3742 N Chatterton Way, Boise ID 83713

Inventor's Signature

Date

3/11/03

Full Name of # 3 joint inventor: Chad Stevens

Citizenship: US

Residence: 1521 W. Alturas ~~SS~~, Boise, ID 83702

Post Office Address: Same as above

Inventor's Signature

Date

5/04/2003

Full Name of # 4 joint inventor: J. <sup>71</sup> Travis Parry

Citizenship: US

Residence: 4530 N. Lusitano, Boise, ID 83713

Post Office Address: Same as above

Inventor's Signature

Date

03/04/2003

Full Name of # 5 joint inventor:

Citizenship:

Residence:

Post Office Address:

Inventor's Signature

Date

Full Name of # 6 joint inventor:

Citizenship:

Residence:

Post Office Address:

Inventor's Signature

Date

Full Name of # 7 joint inventor:

Citizenship:

Residence:

Post Office Address:

Inventor's Signature

Date

Full Name of # 8 joint inventor:

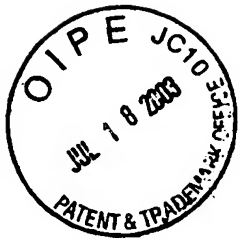
Citizenship:

Residence:

Post Office Address:

Inventor's Signature

Date



Attorney Docket 10016958-1

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:

Sesek, et al.

Group Art Unit: 2900

Serial No.: 10/052,735

Examiner:

Filed: January 18, 2002

Docket No. 050820-1420

For: System and Method for Sending Documents

**Assistant Commissioner of Patents**

**Washington, D.C. 20231**

**ATTENTION: Supervisory Patent Examiner, Unit 2900**

**ASSENT OF ASSIGNEE TO CORRECTION  
AND/OR ADDITION OF INVENTOR(S) AND CERTIFICATION UNDER 37  
CFR 3.73(b)**

In view of the Assignment filed for recordation on 04/30/02 and recorded at Reel 012868, Frame 0053, Assignee hereby certifies that it is the owner of the above referenced application and assents to the correction of Inventorship filed herewith, which is in accordance with 37 C.F.R. § 3.73(b).

In addition, subsequent to a previous filing of a new power of attorney, the Applicant realized that ownership certification and supporting documentation said to be with the power of attorney were not included, but are hereby submitted.

*Charles N. Charnas*

Name: Charles N. Charnas  
Title: Vice President, Deputy General Counsel  
And Assistant Secretary

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JUL 21 2003

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